

REMARKS

In response to the telephone discussion with Examiner Zucker regarding continued prosecution, Applicants elect "(R,S)-2-methoxy-4-phenylbut-3-enoic acid" which can be found in the specification on page 21 at Example 3 and the first compound of currently amended claim 8.

The claims have been amended to place them in a format more customary to US practice. Support for new claims 16-17 can be found in original claim 2. Support for new claim 18 can be found in original claim 7.

Support for the proviso language in claim 1, can be found in original claim 1 and original claim 8. See also, *In re Johnson and Farnham*, 558 F.2d 1008, 194 U.S.P.Q. 187 (C.C.P.A. 1977) and MPEP section 2173.05(i) which states: "Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims".

No new matter has been added.

The Resections Under 35 USC & 112

The rejections are overcome by the amendments to the claims. Thus, it is respectfully requested that the rejection be withdrawn.

Rejections under 35 USC 102

Claims 1-4, 6 and 8 stand rejected as being anticipated by He et al. Claims 1, 3-8 and 14 stand rejected as being anticipated by Davies et al.

In paragraph 6 of the Office Action the Examiner cites compounds 5a of He et al. and in paragraph 7 of the Office Action the Examiner cites compound 5a of Davies et al. With regards to He et al, compounds where R¹ is H fall outside the scope of present claim 1. With regards to Davies et al, compounds where R³ is H fall outside the scope of present claim 1.

With regards to Davies compound 8a, is believed that the proviso to claim 1 render the remaining rejections under 35 USC §102 moot.

Thus, it is respectfully requested that the rejection be withdrawn.

Double Patenting Rejections

A terminal disclaimer is filed herewith overcoming these rejections.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,
/Anthony Zelano/
Anthony Zelano, Reg. No. 27,969
Attorney/Agent for Applicant(s)

/Jennifer Branigan/
Jennifer Branigan, Reg. No. 40,921
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410
Attorney Docket No.: MERCK-3129
Date: **20 November 2009**